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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/293,266	04/16/1999	RAYMOND WALDEN BENNETT III	A00513	4651

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EXAMINER

AGDEPPA, HECTOR A

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/293,266

Applicant(s)

BENNETT III ET AL.

Examiner

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is in response to applicant's response filed on 12/9/02. Claims 1-19 are now pending in the present application. **This action is made final.**

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1 – 4, 6, 8 – 11, 13 – 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Mirville et al.

As to claims 1 – 4, 6, 8 – 11, 13 – 17, and 19, Brandon teaches an automated telephone directory for creating outgoing call logs wherefrom called numbers and/or the names associated with the called numbers may be displayed <sup>on</sup> display 3 of telephone 1,

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retrieved, and dialed by a single input made by depressing call key 82. (Abstract, Figs. 1, 4 – 7, Col. 2, lines 32 – 67, Col. 3, line 54 – Col. 4, line 34, and Col. 5, line 7 – Col. 6, line 64)

However, it is able old and well known that service residing in/on a telephone unit may be provided at a central office (C.O.) or switch, the functionality no longer residing with the telephone, but within the C.O. or switch requiring a caller to dial a service code to invoke a feature and presenting any information via audio messaging. Examples of this are voice mail (as opposed to an answering machine) and remote access speed dialing (as opposed to local speed dialing, i.e., database kept in switch as opposed to being kept in telephone unit) such as the system for on-demand communications services taught by Mirville et al.

Mirville et al. teach a caller using telephone or end unit 101, 103, 105 to dial a service code such as #1 to access the speed dial feature and wherein the list of speed dial numbers resides in a storage device 190 separate from units 101, 103, or 105. (Figs. 1, 3, 4, Col. 6, lines 28 – 54)

It would have been obvious to one skilled in the art to implement the invention of Brandon in the manner taught by Mirville et al., i.e. functionality residing away from the telephone, making it thus necessary to dial a service code and receive relevant information via audio messaging inasmuch as it is old and well known to implement telephony features in either environment. Furthermore, keeping an outgoing call log in a C.O. or switch allows for more memory and therefore a more extensive outgoing call log may be kept. Also, situations arise if outgoing call logs kept only on telephone unit

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wherein if a caller has multiple telephones, that caller must use the same telephone previously used in order to redial a previously called number, because there is no way for that previously dialed number to be transferred to another telephone. Also, because, often, listening to audio messages, in particular, those reciting lists are difficult to remember and use information contained therein, visually displaying lists is favored. However, many telephones commonly used today still do not display information and thus, lists would have to be presented via audio messaging. Furthermore, such is simply an issue of preference or design choice as to whether an outgoing call list is to be presented visually or via audio messaging. Also, to that point, a blind caller would have to have information normally visually displayed, converted to audio or Braille, in either case, requiring converting data into a preferred format and such conversions are old and well known in the art, again making the modification of Brandon's invention from a visual apparatus to an audio apparatus obvious to one skilled in the art.

3. Claims 5, 7, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Mirville et al. and further in view of Levine.

As to claims 5, 12, and 18, Brandon and Mirville et al. have been discussed above. What they do not teach is the use of a vertical service code.

However, any type of service code used to access a service or feature is a question of preference or design choice making the use of a vertical service code obvious to one skilled in the art. Furthermore, as taught by Levine, vertical service codes are old and well known in the art and it would again be obvious to access redial features of the claimed invention using such. (Col. 12, lines 1 – 46 of Levine)

As to claim 7, Brandon teaches displaying outgoing call lists one page at a time. If this were translated into audio, it is obvious if not inherent that call lists would be presented in blocks likened to pages, perhaps 4 numbers at a time to make it easier for a user to utilize redial feature or at least present numbers one at a time, requiring a user to somehow prompt a next number to be presented. Therefore, the page scrolling taught by Brandon would be translated into the first and second audio messages and multiple dial inputs of the claimed invention. Also, as discussed above, as in the case of voice mail or many other services provided remotely to a user, a PIN would be necessary and thus it is obvious if not inherent to require the inputting of a PIN as claimed by the instant invention.

#### ***Response to Arguments***

4. Applicant's arguments filed 12/9/02 have been fully considered but they are not persuasive.

As to Applicant's first argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In addition, a suggestion/motivation **need not be expressly stated** in one or all of the references used to show obviousness. *Cable Electric Products, Inc. V. Genmark*,

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*Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985); *In re Sheckler*, 438 F.2d 999, 1001, 168 USPQ 716, 717 (CCPA 1971). It is assumed that every reference relies to some extent on the knowledge of persons skilled in the art to complement that which is disclosed therein. Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In other words, **the person having ordinary skill in the art has a level of knowledge apart from the content of the references.** *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1969)

This relates to suggestion/motivation in that "having established that this knowledge was in the art, the Examiner could then properly rely ... on a conclusion of obviousness 'from **common knowledge and common sense** of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference'." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)

As to using the present invention as a blueprint to pick and choose isolated elements from the prior art, Brandon is used for its automated directory feature while Mirville et al. simply teach using service codes instead of a dedicated keypad. All the elements claimed in the present invention are found or very obvious in lieu of these two references. If 2 references have various features that can be combined to form the present invention, such may be picking and choosing elements, but they are already existent and in no way suggest an improper combination of references. The very nature of combining references implies that certain features will be taken from one reference and combined with certain features of another, or more if required. Patentability does

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not wholly rest on claiming an invention which has a certain combination of features, all of which can be found elsewhere, but not just together in one invention. This is the very reason for the obviousness rejection.

As to Applicant's second argument, whether by key or by code, a feature of the invention is to be accessed. Brandon teaches a modified telephone unit, but one can clearly tell that it is still a phone that operates in the standard manner, meaning that ANY telephone unit, including that of Brandon is able to dial a feature code. ANY telephone can be used to dial \*69, \*67, \*70, etc to activate a feature. The mere fact that for "some" of its features, the telephone unit of Brandon is "configured," i.e., it is an obvious design choice or preference, to use a dedicated keypad would not prevent one skilled in the art from using access codes as claimed. Again, this is very old and well known and merely a design choice, having many motivations already addressed in the previous office action.

As to Applicant's 3<sup>rd</sup> argument, Examiner is using Mirville et al. to show that it is old and well known to present information via audio messages ONLY. Then, taking into account that fact that Brandon can present a list of previously called parties, to do so via audio messages would also be obvious. Voice mail generates audio messages and menus, IVR, VRU are all old and well known. Such audio features/functions standard in telephony systems. It is merely design choice or preference to decide to use them or not.

Applicant seems to believe that their invention is patentable merely because they present a list of previously called parties via audio instead of visually. Audio delivery is



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just an implementation issue/choice because presentation of information using audio is so old and well known. There is nothing about the Brandon telephone that teaches away from using audio messages to present information. Brandon simply has certain features located on the actual phone, but again, this is merely a design choice or preference.

As to claims 5, 7, 12, and 18, it can clearly be seen from the claims that a vertical service code plus a PIN is the equivalent of a service code which is claimed in claim 1 for example. Both are merely variations on how to access a feature of the claimed invention. Therefore, once again, what Applicant deems patentable is merely a design choice or preference.

Applicant seems to want any reference used to reject the present invention to have all the elements therein. If such were actually the case, there would be no need for the obviousness rejection.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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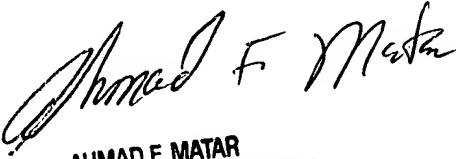
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

H.A.A.  
February 21, 2003

  
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